

TTAB

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Kim M. Bacon (Name)
11/1/04 (Date)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re the Application of:)
Applicant: Alexandria Real Estate Equities, Inc.)
Serial No.: 75/982,917)
Filed: December 29, 2000)
Mark: LABSPACE)

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

APPLICANT'S REPLY TO EXAMINING ATTORNEY'S APPEAL BRIEF

Alexandria Real Estate Equities, Inc. ("Applicant"), hereby files its Reply to the Examining Attorney's Appeal Brief pursuant to TMEP 1501.02(a).

To refuse registration on the ground that a mark is descriptive, the Examining Attorney must make a substantial showing based on clear evidence of descriptive use. *In re Kopy Kat, Inc.*, 182 U.S.P.Q. 372 (C.C.P.A. 1974). In her Appeal Brief (at pages 7-8), the Examining Attorney asserts:



The applicant's services include business incubator services, start up support, business financing and leasing of computers. Therefore, it is clear from the evidence of record that the applicant's services specifically relate to providing business, equipment and financing support to businesses seeking to acquire "lab", or "laboratory", space. As noted previously, it is not necessary that the wording "lab space" describe all of the applicant's services. Rather, it is sufficient for a finding of descriptiveness that "lab space" describe a purpose or feature of the applicant's services. The function of the evidence of record is to establish that the wording "lab space" and "laboratory space" are descriptive designations as related to businesses, business incubators and business financing services. The wording "lab space" does indeed describe a physical location, and this is exactly the focus of the applicant's services.

However, the references cited by the Examining Attorney do not evidence use of the term "lab space" or "lab space" as "descriptive designations" for any business or financial services—they just show use of the term to refer to physical laboratory facilities. As such, no evidence has been cited—let alone clear evidence—of descriptive use of the Mark. Applicant respectfully submits that the mark is not descriptive as applied to *any* of applicant's listed services.

The present LABSPACE application lists the following services:

1. Business consulting services;
2. Business incubator services, namely business management and business development services in the form of start-up support for businesses of others;
3. Rental and leasing of office machinery and equipment;
4. Investment brokerage, consultation and management;
5. Financial portfolio management; financial services, namely financial consultation, financial analysis, financial planning, financial management, financial portfolio management, financing services, and providing debt and equity capital; incubator financing services; and
6. Rental and leasing of computers.

It is well established that "[p]ursuant to the general rule that registrability is determined solely on

the basis of the goods or services specified in the registration, the descriptiveness of the designation sought for registration is determined on the basis of the goods or services listed in the application, not the goods or services actually used or intended to be used. McCarthy, Trademarks and Unfair Competition § 11:51 (4th Ed., 2004) (emphasis added). When viewed in connection with Applicant's listed services, the Mark is not descriptive.

Courts have also noted that it is not enough to say that a mark at issue identifies the subject matter of an applicant's business. For example, in *Dial-A-Mattress Operating Corp. v. MattressMadness, Inc.*, 841 F. Supp. 1339, 1347-48, 33 U.S.P.Q. 2d 1961 (E.D.N.Y. 1994), the Court stated that "[t]he phrase 'dial-a-mattress,' while certainly establishing a link between the telephone and bedding products, does not begin to describe the nature, scope or extent of the services that the name has come to represent. (See *Blisscraft of Hollywood v. United Plastics Co.*, 294 F. 2d 694, 699-700 (2d Cir. 1961) (mark not descriptive merely because it identifies subject matter)."

Similarly in *Citibank N.A. v. Citibanc Group, Inc.*, 724 F.2d 1540, 222 U.S.P.Q. 292 (11th Cir. Ala. 1984), the Court held that "CITIBANK" was not merely descriptive of plaintiffs' banking services: "The term 'Citi' does not describe a class of banking services or a characteristic of banking services. As the district court stated, 'the most that can be said for City Bank is that it suggest a modern or urban bank.'...To paraphrase Professor McCarthy, we find that Citibank indicates not a type of service, but a provider of that service." *Id.* at 1545.

The Examining Attorney notes that to be merely descriptive, the Mark must "describe a purpose or feature of the applicant's services." (Appeal Brief at 7) However, the term LABSPACE does not describe any "purpose" or "feature" of Applicant's identified services. As in *Citibank*, the most that can be said for the mark LABSPACE is that it suggests a physical location with laboratory facilities but it does not describe in any way the variety of business and

financial services Applicant provides to its customers who are typically companies engaged in scientific, research or emerging technology fields. Indeed, not all of the companies or facilities that engage Applicant's services operate or use "laboratories". In *Public Service Co. v. Nexus Energy Software, Inc.*, 36 F. Supp. 2d 436, 50 U.S.P.Q.2d 1317 (D. Mass. 1999), the Plaintiff, a public utility company, used the mark "ENERGY PLACE" for:

[P]roviding information services regarding the most efficient and cost-effective use of energy resources; providing energy audits for industrial, commercial, and residential consumers; energy consulting services; managing energy consumption for industrial and commercial consumers; promoting public awareness for the need for more efficient and cost-effective use of energy resources... .

Id. at 438. The Court found that ENERGY PLACE is only suggestive of Plaintiff's services because "[a]lthough the term 'ENERGY PLACE' suggests that is a place related to energy, it does not convey an immediate idea of the ingredients, qualities, or characteristics of the services [Plaintiff] offers...Moreover, competitors are left with a variety of terms to describe their competing services, one example being energy information services." *Id.* at 439. Similarly, LABSPACE does not immediately convey information about the types of services that Applicant offers, and competitors can use many other terms to describe competing services, e.g., "incubator development services," or "research investment services."

The cases cited by the Examining Attorney are distinguishable from the present situation. In each of these cited cases the mark at issue clearly identified key features or elements of the goods/services listed in the applicants' applications. For example, in *In re Tower Tech, Inc.*, 64 U.S.P.Q.2D 1314 (TTAB 2002), the applicant sought to register the mark SMARTTOWER for goods that included computer controlled "commercial and industrial cooling towers and accessories therefor, sold as a unit." Thus, the mark in question was held to describe one of the specific types of goods enumerated in the application—i.e., automated cooling "towers."

Similarly, in *In re Sun Microsystems, Inc.*, 59 U.S.P.Q.2d 1084 (TTAB 2001), the Board affirmed refusal of the mark AGENTBEANS for software that included types of programs which are referred to as “agent” and “beans” programs in the relevant industry; in *In re Putman Publishing Co.*, 39 U.S.P.Q.2d 2021 (TTAB 1996), the mark FOOD & BEVERAGE ON-LINE was deemed descriptive of an on-line database offering food and beverage news and information “devoted exclusively to the food and beverage industry”; in *In re Copytele, Inc.*, 31 U.S.P.Q.2D 1540 (TTAB 1994), refusal was affirmed for the mark SCREEN FAX PHONE for use on terminals that contain as principal parts “a screen, a facsimile transmission device, and a telephone”; and in *In re Entenmann’s, Inc.*, 15 U.S.P.Q.2d 1750 (TTAB 1990), the mark OATNUT was determined to be descriptive of bread which features oats and nuts as principal ingredients.

In the present case, the term LABSPACE does not give any information about the nature of the business and financial services listed in the subject application. At most, the Mark is only suggestive that Applicant provides its services to, among others, companies that may have laboratories or other research facilities. In cases (such as the present case) where the mark at issue does not identify the nature of an applicant’s listed services, such marks have not been found to be merely descriptive. For example, in *In re TBG Inc.*, 229 U.S.P.Q. 759 (TTAB 1986), the Board held that the mark SHOWROOM ONLINE is only suggestive of applicant’s listed services of “leasing databases and video disks in the field of interior furnishing and related products of others.” The Board noted that the mark must be considered in relation to the services identified by the applicant, and therefore it was not enough to say that the mark “conveys the immediate idea of providing an interior furnishings showroom by means of a computer terminal.” Although the applicant provided an online information retrieval system which

provided information regarding interior furnishings which users could access to make purchasing decisions, the mark SHOWROOM ONLINE “has no obvious meaning in relation to appellant’s listed services of leasing computer data bases and video disks in the field of interior furnishing and related goods.” As demonstrated with similar registered marks, and consistent with the law discussed above, the PTO has determined that such marks are not merely descriptive. In its Appeal Brief (at page 4) Applicant cited-- as examples only-- similar service marks that have been allowed to register on the Principal Register (copies of which are attached with a Notice of Reliance in Exhibit 1): i.e., “MEDSPACE” for medical facility planning and design services,” “TECHSPACE” for “leasing temporary space to technology, new media and entertainment companies,” and “ARTSPACE” for “real estate development addressing the space needs of artists and arts organizations, and consulting related thereto.”¹

Therefore, in light of the above arguments, and the established rule that “any doubt with respect to the issue of descriptiveness should be resolved in Applicant’s behalf,” *In re Grand Metropolitan Foodservice, Inc.*, 30 U.S.P.Q. 2d 1974, 1976 (T.T.A.B. 1994), Applicant’s Mark should be allowed to become registered on the Principal Register.

¹ In its Appeal Brief, Applicant cited these marks as examples without attaching the registration certificates. Applicant apologizes for this oversight and the registration certificates and TARR records for these registrations are attached hereto as Exhibit 1. These references are not cited as controlling authority, but rather only as exemplars demonstrating how the PTO has applied the relevant law in a way consistent with the cited law.


CONCLUSION

In view of the foregoing, Applicant submits that this application is now in condition for acceptance. Favorable action is therefore requested.

Respectfully submitted,

COOLEY GODWARD LLP

Date: November 1, 2004

By: 
Susan D. Berney-Key

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Attorneys for Applicant
Alexandria Real Estate Equities, Inc.

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James M. Bacon (Name)
11/1/04 (Date)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re the Application of:)
Applicant: Alexandria Real Estate Equities, Inc.)
Serial No.: 75/982,917)
Filed: December 29, 2000)
Mark: LABSPACE)
_____)

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

NOTICE OF RELIANCE

Alexandria Real Estate Equities, Inc. ("Applicant"), hereby submits this Notice of Reliance in support of the attached third party registrations, pursuant to TBMP §§ 704.02 and 704.03(b)(1)(B).

Applicant hereby submits as Exhibit 1 copies of the following third party registrations (and print-outs from the TARR database for these registrations): MEDSPACE (Registration No.

1,487,906), TECHSPACE (Registration No. 2,364,892) and ARTSPACE (Registration No. 2,282,852). The relevance of this evidence is to provide exemplars of marks for services similar to the services in Applicant's present Mark where the PTO has determined that the marks are not merely descriptive and the marks have been allowed to become registered on the Principal Register for the listed services. See Applicant's Appeal Brief at Page 4, and Applicant's Reply Brief at Page 6.

Respectfully submitted,

COOLEY GODWARD LLP

Date: November 1, 2004

By: Susan D. Berney-Key
Susan D. Berney-Key

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Palo Alto, California 94306-2155
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Attorneys for Applicant
Alexandria Real Estate Equities, Inc.

Int. Cl.: 42

Prior U.S. Cl.: 100

United States Patent and Trademark Office

Reg. No. 1,487,906
Registered May 10, 1988

SERVICE MARK
PRINCIPAL REGISTER

MEDSPACE

MEDSPACE, INC. (KANSAS CORPORATION)
P.O. BOX 47648
WICHITA, KS 67201

FIRST USE 5-9-1983; IN COMMERCE
10-19-1983.

FOR: MEDICAL FACILITY PLANNING AND
DESIGN SERVICES, IN CLASS 42 (U.S. CL. 100).

SER. NO. 643,644, FILED 2-9-1987.
G. MAYERSCHOFF, EXAMINING ATTORNEY

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2004-11-01 20:20:55 ET

Serial Number: 73643644

Registration Number: 1487906

Mark (words only): MEDSPACE

Standard Character claim: No

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 1995-01-17

Filing Date: 1987-02-09

Transformed into a National Application: No

Registration Date: 1988-05-10

Register: Principal

Law Office Assigned: (NOT AVAILABLE)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -File Repository (Franconia)

Date In Location: 1996-02-09

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. MEDSPACE, INC.

Address:

MEDSPACE, INC.

P.O. BOX 47648

WICHITA, KS 67201

United States

Legal Entity Type: Corporation

State or Country of Incorporation: Kansas

GOODS AND/OR SERVICES

International Class: 042

MEDICAL FACILITY PLANNING AND DESIGN SERVICES

First Use Date: 1983-05-09

First Use in Commerce Date: 1983-10-19

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

1995-01-17 - Section 8 (6-year) accepted & Section 15 acknowledged

1994-11-03 - Response received for Post Registration action

1994-09-01 - Post Registration action mailed Section 8 & 15

1994-03-16 - Section 8 (6-year) and Section 15 Filed

1988-05-10 - Registered - Principal Register

1988-02-16 - Published for opposition

1988-01-17 - Notice of publication

1987-10-16 - Communication received from applicant

1987-12-07 - Approved for Pub - Principal Register (Initial exam)

1987-10-30 - Communication received from applicant

1987-05-18 - Non-final action mailed

1987-04-30 - Case file assigned to examining attorney

CORRESPONDENCE INFORMATION

Correspondent

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JOHN W. CARPENTER
107 N. MARKET, SUITE 401
WICHITA, KS 67202-1806

Int. Cl.: 36

Prior U.S. Cls.: 100, 101, and 102

United States Patent and Trademark Office

Reg. No. 2,364,892

Registered July 4, 2000

**SERVICE MARK
PRINCIPAL REGISTER**

TECHSPACE

**TECHSPACE, LLC. (DELAWARE CORPORATION)
666 FIFTH AVENUE
24TH FLOOR
NEW YORK, NY 10103**

**FOR: LEASING TEMPORARY SPACE TO TECH-
NOLOGY, NEW MEDIA AND ENTERTAINMENT**

**COMPANIES, IN CLASS 36 (U.S. CLS. 100, 101 AND
102).**

FIRST USE 7-0-1997; IN COMMERCE 3-0-1998.

SN 75-311,754, FILED 6-19-1997.

MATTHEW PAPPAS, EXAMINING ATTORNEY

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2004-11-01 20:21:20 ET

Serial Number: 75311754 Assignment Information

Registration Number: 2364892 Assignment Information

Mark (words only): TECHSPACE

Standard Character claim: No

Current Status: Registered.

Date of Status: 2000-07-04

Filing Date: 1997-06-19

Transformed into a National Application: No

Registration Date: 2000-07-04

Register: Principal

Law Office Assigned: LAW OFFICE 104

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -File Repository (Franconia)

Date In Location: 2000-07-13

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Techspace, LLC.

Address:

Techspace, LLC.
666 Fifth Avenue 24th Floor
New York, NY 10103
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

International Class: 036

leasing temporary space to technology, new media and entertainment companies

First Use Date: 1997-07-00

First Use in Commerce Date: 1998-03-00

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2000-07-04 - Registered - Principal Register

2000-05-02 - Allowed for Registration - Principal Register (SOU accepted)

2000-04-22 - Case file assigned to examining attorney

2000-04-13 - Statement of use processing complete

2000-02-16 - Amendment to Use filed

1999-08-30 - Extension 2 granted

1999-08-24 - Extension 2 filed

1999-03-23 - Extension 1 granted

1999-02-24 - Extension 1 filed

1998-08-25 - Notice of allowance - mailed

1998-06-02 - Published for opposition

1998-05-01 - Notice of publication

1998-03-20 - Approved for Pub - Principal Register (Initial exam)

1998-03-16 - Examiner's amendment mailed

1998-03-05 - Non-final action mailed

1998-03-02 - Case file assigned to examining attorney

CORRESPONDENCE INFORMATION

Correspondent

KEVIN HEALY, ESQ. (Attorney of record)

KEVIN HEALY, ESQ.
PROSKAUER ROSE LLP
1585 BROADWAY
NEW YORK NY 10036

Int. Cl.: 37

Prior U.S. Cls.: 100, 103 and 106

United States Patent and Trademark Office

Reg. No. 2,282,852

Registered Oct. 5, 1999

**SERVICE MARK
PRINCIPAL REGISTER**

ARTSPACE

ARTSPACE PROJECTS, INC. (MINNESOTA
CORPORATION)
528 HENNEPIN AVENUE, STE. 404
MINNEAPOLIS, MN 554031810

SULTING RELATED THERETO, IN CLASS 37
(U.S. CLS. 100, 103 AND 106).
FIRST USE 8-10-1979; IN COMMERCE
11-1-1985.

FOR: REAL ESTATE DEVELOPMENT AD-
DRESSING THE SPACE NEEDS OF ARTISTS
AND ARTS ORGANIZATIONS, AND CON-

SER. NO. 75-452,659, FILED 3-18-1998.

MELVIN AXILBUND, EXAMINING ATTOR-
NEY

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2004-11-01 20:22:09 ET

Serial Number: 75452659

Registration Number: 2282852

Mark (words only): ARTSPACE

Standard Character claim: No

Current Status: Registered.

Date of Status: 1999-10-05

Filing Date: 1998-03-18

Transformed into a National Application: No

Registration Date: 1999-10-05

Register: Principal

Law Office Assigned: LAW OFFICE 113

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -File Repository (Franconia)

Date In Location: 1999-10-08

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Artspace Projects, Inc.

Address:

Artspace Projects, Inc.
528 Hennepin Avenue, Ste. 404
Minneapolis, MN 554031810
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Minnesota

GOODS AND/OR SERVICES

International Class: 037

real estate development addressing the space needs of artists and arts organizations, and consulting

related thereto

First Use Date: 1979-08-10

First Use in Commerce Date: 1985-11-01

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2004-08-16 - TEAS Change of Correspondence Received

1999-10-05 - Registered - Principal Register

1999-07-13 - Published for opposition

1999-06-11 - Notice of publication

1999-04-12 - Approved for Pub - Principal Register (Initial exam)

1999-03-16 - Communication received from applicant

1999-02-02 - Final refusal mailed

1999-01-08 - Communication received from applicant

1998-11-25 - Non-final action mailed

1998-11-18 - Case file assigned to examining attorney

1998-06-26 - Applicant amendment prior to exam entered

CORRESPONDENCE INFORMATION

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